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|-----------------|-------------|----------------------|---------------------|------------------|
| 09/472,900      | 12/28/1999  | KAZUE SAKO           | 059729/0111         | 9353             |

7590 01/27/2004

FOLEY & LARDNER  
WASHINGTON HARBOUR  
3000 K STREET NW SUITE 500  
P O BOX 25696  
WASHINGTON, DC 200078696

EXAMINER

FISHER, MICHAEL J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3629

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/472,900

Applicant(s)

SAKO, KAZUE

Examiner

Michael J Fisher

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Franklin et al. (Franklin).

Franklin discloses a method for placing a bid comprising the bidder determining, or choosing, a bid price (col 8, lines 47-53), obtaining a code parameter corresponding to the bid price (col 10, lines 40-47), this parameter would inherently be predetermined as the parameter corresponds to a particular bid as each bid would have an ASCII or HTML code associated with it (both for amount and bidder), encoding the bid with the code parameter and transmitting the encoded bid to a bid-receiving system (S).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin.

Franklin discloses an electronic tender system comprising bidder sub-systems (B), including a code parameter acquisition section for receiving a bid and for acquiring a code parameter corresponding to the bid, this parameter would inherently be predetermined as it corresponds to a bid, a code processing section for using the code parameter to encode the bid and a transmission section for sending the bid to a tender opening sub-system (see col 2, line 61-col 3, line 49, and further, col 8, lines 47-53 and further, claims 1 and 5), and a tender opening sub-system (S), including a reception section for receiving messages from the bidder sub-systems until a closing time, a candidate price selection section (col 9, lines 3-52), a decode parameter acquisition section and a determination section for decoding encoded bids (see col 10, line 52-col 11, line 15 and further, claim 10). The code parameters would inherently be predefined, (such as ASCII or HTML codes), and further. There would be different codes for bidders and for bids, as both would have different objects encoded and these codes would inherently be associated with each other so that a winning bid would be related to a bidder to ascertain who won the bid.

As to claims 3 and 4, public and private keys are disclosed (see col 4, lines 19-38 and claim 14).

As to claims 5-8, an announcement section is disclosed (see col 9, line 53-col 10, line 2).

As to claim 11, the public key would be that which the bidder would use to place the bid.

As to claim 12, the bid would be encoded as this would make it comprehensible to a computer.

As to claim 13, a secret key would be that which is only used by the site's administrators, as is discussed in col 4, lines 11-16).

As to claim 14, codes would be decoded by the computer to allow the site administrators to read the bids.

### ***Response to Arguments***

Applicant's arguments filed 10/31/03 have been fully considered but they are not persuasive. As is discussed above, the code would inherently be predetermined to correspond to a particular bid else the system would continuously need input to determine exactly how to code the bid. As to arguments that in the instant application the code corresponds to a bid and not a bidder, it would appear to the examiner to be the same thing as the bid corresponds to the bidder and thus, the code would

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correspond to both the bid and the bidder. As to arguments that the instant application is different in that it only discloses the winning bid, applicant is directed to col 10, lines 3-4 of Franklin wherein Franklin discloses erasing losing bids and the information related to it, this would appear to be correspond to the instant application. As to arguments that equal bids would be coded differently, while Franklin does not specify this it appears that the applicant does not either. Specifically, the differing bids would, of necessity, be coded differently as they are related to different bidders. If the bids were encoded only according to amount there would appear to be no way to determine the winning bidder as the bids would not be related to a bidder, therefore, it appears that identical bids would necessarily be encoded differently to separate bidders. The code for the amount would be coded the same, but the code for the bidder would necessarily be different. Further, Franklin would inherently differentiate between bids to decide the winning bid it would open the bids and compare them to decide the winning bid. Further, Franklin appears to impose a tenderable range, zero would be the minimum, and the amount the purchaser actually controls would be the maximum (Franklin discusses the maximum in col 5, line 65-col 6, line 7). Further, the examiner must read the claims in their broadest sense. As is discussed in the above rejection, the prior art anticipates the claims of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Fisher whose telephone number is 703-306-5993. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

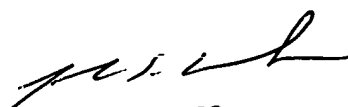
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The fax phone number for the organization where this application or proceeding is assigned is 703-306-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

MF

1/25/04

  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600